

REMARKS

The Examiner objected to the specification, because the specification did not provide antecedent basis for "determining the dimensions of said print medium from a plurality of images of portions of said edge" in Claim 10. The above amendment to Claim 10 cures any such defect.

The Examiner objected to Claim 1 because the Examiner maintains that "said edge" lacked antecedent basis. Applicant disagrees. The first paragraph of Claim 1 refers to an edge and recites four choices for that edge.

The Examiner also objected to Claim 9 for the same reason. The above amendments to Claim 5 provide the required antecedent basis.

The Examiner also objected to Claim 9 because the claim required determining the dimensions of the print medium from a single edge. Applicant presumes that the Examiner intended to object to Claim 10 in this respect. The above amendments to Claim 10 correct any such problem.

The Examiner rejected Claims 1-9 under 35 U.S.C. 102(e) as being anticipated by Endo (US 2004/0246285). Applicant traverses this rejection. The Examiner has the burden of showing by reference to the cited art each claim limitation in the reference. Anticipation under 35 U.S.C. 102 requires that each element of the claim in issue be found either expressly or inherently in a single prior art reference. *In re King*, 231 USPQ 136, 138 (Fed. Cir. 1986); *Kalman v. Kimberly-Clark Corp.*, 218 USPQ 781, 789 (Fed. Cir. 1983). The mere fact that a certain thing may result from a given set of circumstances is not sufficient to sustain a rejection for anticipation. *Ex parte Skinner*, 2 USPQ2d 1788, 1789 (BdPatApp&Int 1986). "When the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the reference" (*In re Rijckaert*, 28 USPQ2d, 1955, 1957).

In making this rejection, the Examiner stated that Endo teaches an imaging device for forming an image of a portion of an edge of a print medium. The Examiner specifically points to sensor 29 of Endo. Applicant must disagree with the Examiner's reading of Endo. Sensor

29 is a single photodetector that detects changes in the reflectivity of the print medium as the detector moves across the print medium and paper carriage. There is no teaching in Endo of forming an image of a portion of an edge with this sensor. Accordingly, Endo lacks at least one of the limitations of Claims 1 and 5, and hence, Endo does not anticipate Claims 1 and 5, or the claims dependent therefrom.

With regards to Claims 2 and 8, the Examiner stated that the controller determines a brightness value for the print medium from the image. First, as noted above, Endo does not teach forming an image. Second, the cited paragraph refers to measuring the output of the photo sensor, not measuring a brightness value for the print medium. The brightness value depends the absolute intensity of the light source and the gain of the photo sensor. Hence, there are additional grounds for allowing Claim 2.

The Examiner rejected Claim 10 under 35 U.S.C. 103(a) as being unpatentable over Endo in view of Hiramatsu, *et al* (hereafter "Hiramatsu") (US 5,168,291). Applicant traverses this rejection and repeats the arguments made above with respect to the missing teachings in Endo with respect to Claim 5. Hiramatsu does not provide the missing teachings.

In addition, Hiramatsu only teaches determining the width of the paper. The sensor taught therein does not measure the length of the paper. Hence, there are additional grounds for allowing Claim 10.

I hereby certify that this paper is being sent by FAX to 571-273-8300.

Respectfully Submitted,


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